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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/095,325	06/10/1998	GENE EGGLESTON	PD05513AWD01	9524

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EXAMINER

CARDONE, JASON D

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 06/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/095,325

Applicant(s)

Eggleston et al.

Examiner

Jason D. Cardone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 11, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-114 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-114 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 22, 25 6) ☒ Other: See Attached Office Action

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DETAILED ACTION

Response to Amendment

1. This action is responsive to the amendment of the applicants (Paper No. 23) filed on 4/11/02. Claims 33-114 are presented for further examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 33-114 are objected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No amendment in an application under this paragraph may introduce new matter or matter that would have been new matter in the prior application. The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is not adequately described in the specification and which is not contentional in the art or known to one ordinary skill in the art. The Federal Circuit has pointed out the under United States law, a description that does not render a claimed invention obvious cannot sufficiently describe the invention for the purposes of the written description requirement of 35 U.S.C. 112 [See Paper No. 21 for court citing]. While there is no in haec verba

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requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of filing date sought, applicant was in possession of the invention as now claimed. Such a review is conducted from the standpoint of one of skill in the art at the time the application was filed. The independent claims 33, 54-56, 60, 64, 65, 69, 92, 95, 98, 104, 106, 109, and 113 disclose a first address at or associated to the host system as seen from the plurality of clients as the address of the mobile client. An example is claim 33, which discloses receiving messages directed to a first address at the host system from a plurality of message senders and continuously forwarding the messages of that address to the mobile client. Claim 33 further discloses that reply messages from the mobile client would be replied through the host system to the plurality of clients and appear that the reply message originated at the first address associated with the host system. Another example is claim 69, which discloses receiving messages directed to a first address at the host system from a plurality of message senders and continuously forwarding the messages of that address to the mobile client and then the host system replying to the plurality of message senders with the reply from the mobile client. There has been a reference to the specification to describe the reply messages are configured to be transparent to the message recipient [Specification, pg 8, lines 1-7 and pg 20 line 21 - pg 21, line 13]. The first paragraph points out a client can have a virtual session with the host system. The second paragraph points out the client controller optimizes the reply message by calculating a difference using a delta routine

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between the reply message and the preceding message. It is to have an optimized reply to be smaller than a normal reply message to provide significant savings to the client in time and costs. One of skill in the art at the time the application was filed would not have recognized that application was in possession of the invention as claimed in view of the disclosure of the application as filed, since an explicit limitation (ie. a first address at or associated to the host system as seen from the plurality of clients as the address of the mobile client) in a claim is not present in the written description [See Paper No. 21 for court citing]. The virtual session and the optimizing a reply message do not specifically disclose a first address at or associated with a host system to be used with the mobile client. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherence, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient" (citations omitted). Furthermore, each claim must include all elements which applicant has described as essential [See Paper No. 21 for court citing].

4. Claims 104, 105, and 109-114 are, also, objected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No amendment in an application

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under this paragraph may introduce new matter or matter that would have been new matter in the prior application. The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is not adequately described in the specification and which is not contentional in the art or known to one ordinary skill in the art.

While there is no in haec verba requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. The independent claims 104, 109, and 113 disclose upon receiving a reply message at a forwarding component associated with a host system, forwarding the received message. There has been a reference to the specification to describe forwarding a sent message to a mobile client [Specification, pg 15, line 20 - pg 16, line 11] and for sending the reply message [Specification, pg 20, line 21 - pg 21, line 32]. The first paragraph points out the host system sending messages to the client (not reversed). The second paragraph points out the client controller optimizes the reply message by calculating a difference using a delta routine between the reply message and the preceding message. Then the client sends the reply message to the host system. One of skill in the art at the time the application was filed would not have recognized that application was in possession of the invention as claimed in view of the disclosure of the application as filed, since an explicit limitation (ie. a forward component to forward messages) in a claim is not present in the written description [See Paper No. 21 for court citing]. The forwarding messages to the mobile client and sending the reply to the message sender do not specifically disclose a forward component to the host system to forward messages. "To establish inherency, the extrinsic evidence must make

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clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherence, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient" (citations omitted). Furthermore, each claim must include all elements which applicant has described as essential [See Paper No. 21 for court citing].

5. Therefore, independent claims 33, 54-56, 60, 64, 65, 69, 92, 95, 98, 104, 106, 109, and 113 (and their dependent claims) are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Request for Interference

6. The office has acknowledged the request for interference by applicants, filed 9/18/01 (Paper No. 20), to the present claims 33-68 but (as shown above) the instant claims are not in order for allowance at this time. See MPEP 2301.1(c).

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Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone, whose telephone number is (703) 305-8484. The examiner can normally be reached on Monday through Thursday from 9am to 6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The fax numbers for the organization where this application or proceeding is assigned are as follows:

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(703) 746-7238 (After Final Communications)

(703) 746-7239 (Official Communications)

(703) 746-7240 (For Status Inquiries, Draft Communications)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is (703) 305-3900.



**ROBERT B. HARRELL
PRIMARY EXAMINER**



Jason D. Cardone

June 27, 2002